

## ATTACHMENT 2 – DISCUSSION OF PRIOR ART

PRIOR ART LISTED IN OFFICE ACTION for Serial No. 09/301,868 MAILED 04/03/2007 by Examiner Thakur, Viren A, rejoining claims 1-9.

Responsive to the rejections as stated in the office action based in various combinations of:

Applied to claims 1 and 6

### **BARTON (US 4635291)**

Examiner states that Barton discloses a combination comprising

1. a drink bottle (Figure 1, Item B) joined axially with a diminished diameter bottle neck (Figure 1, Item N), the bottle neck terminating at a removable bottle cap (Figure 1, See above item N)
2. a sealed snack package (Figure 2, Item 22) containing a snack food (Column 4, Line 66 to Column 5, Line 4).

The examiner references Figure 1 as showing the snack package is adapted for being wrapped around the bottle neck of the drink bottle, for intimate abutment therewith. Therefore the prior art discloses a sealed snack package would have been capable of being wrapped around the bottle neck.

THE EXAMINER FURTHER states:

“Since the snack package is part of the envelope, said snack package is also intimately positioned against the bottle wall. As a result of this intimate interaction, said snack package would also be been (sic) pressed against the bottle neck...Further regarding instant claim 6, said sealed snack package is wrapped over the bottle neck (Figure1). ...Barton discloses wherein the snack package is wrapping and simultaneously over the bottle neck.

Applied to claims 10 and 14-17

### **Schumacher et al. (US 5465835)**

The examiner states that Schumacher et al. disclose

1. a drink bottle (Figure 1, Item 2);
2. a snack package fabricated as an envelope (Figure 12, Item 11) having an inner wall and an outer wall having a sealable opening mounted on said outer wall (Figure 12, Item 11) – see opening on the top of item 11). Since Schumacher discloses an aperture (Figure 12 – see between item 14 and see between item 11), said aperture is sized and shaped for accepting the bottle neck and removable cap. ...The examiner interprets that if any portion of a wall is in contact with the bottle wall, then said wall is in intimate contact with said bottle wall. ... Since the envelope wraps around the bottle neck ... the prior art discloses the structure of the instant claim limitation. ... The envelope is enclosed by both the bottle cap (Figure 12, Item 8) and a bottom cap (Figure 12, item 8) and a bottom closure (Figure 12, Item 7) in opposition to said bottle cap which enables access to the snack food.

Applied to claims 10, 14-15 and 17

**Muza et al. (US 5397017)**

The examiner states that Muza et.al discloses:

1. a drink bottle;
2. snack package fabricated as an envelope ... but the snack package does not require snack food contained therein, but must merely be capable of receiving a snack food.

The examiner has applied the means-plus function language that invokes 112.6 however, the disclosure does not provide adequate support for what are the applicable functions. Based on the guidelines set forth in MPEP Section 2181 the Examiner has applied the means plus function based on that which would have been known to one having ordinary skill in the art to perform said function.

Applied to claims 10, 14-15 and 17

**Selz (US 4693410)**

The examiner states that Selz discloses:

1. a drink bottle;
2. a snack package fabricated as an envelope (Figure 24, Item 1)
3. an aperture (Figure 4, Item 14) capable of accepting the bottle neck and removable cap and there is a wall (Figure 2, Item 5) intimately against the bottle wall CAPABLE (emphasis added) of securement therewith. ... thus Selz allowing the combination to occupy the same space as the drink bottle alone.

Paragraph 20.

As applied to claims 1-2, 6, 10, 14-15 and 17

**Brauner et al. (US 5372827)**

Examiner states that Brauner et al discloses:

1. a drink bottle;
2. a sealed snack package containing a snack food; and
3. an envelope (Figure 2, item 20) terminating with an aperture positioning an inner surface of said envelope wall intimately against the bottle wall for securement therewith.

Thus Brauner disclose wherein said envelope wraps the neck.

As applied to claims 1-2, 6, 10, 14-15 and 17

**Franco (US 5743423) with Brauner et al.**

The examiner states that Franco on Figure 6 and Column 2, lines 25-33 is cited as further evidence of a commonality of cylindrical bottle to hold fluids such as water.

Paragraph 21.

As applied to claims 1-2, 6, 10, 14-15 and 17 with Brauner

**Singer (US 6085919)**

The examiner states that Singer teaches:

1. a cylindrical bottle comprising a secondary compartment used for storing a prize.
2. annular bosses used to secure a secondary compartment to a bottle neck.

The examiner cites MPEP Section 2144.06 for equivalency analysis. In this case, similar to the instant claims limitations, the annular protuberance of the prior art serves to secure the SNACK (emphasis added) envelope to the bottle. Therefore the prior art serves to perform the same function as that of the instant claim limitation: to removably snap fit a container to a bottle neck.

Paragraph 22.

As applied to claims 3-4, 7-8 and 11-12 along with Brauner

**Lemelson (US3112824)**

The examiner states that Lemelson teaches:

1. cylindrical bottle (figure 9)
  - a. comprising an additional container (Figure 9, Item 11) within which a product, such as a premium, has been contained (Figure 8, Item A);
  - b. an adhesive layer or strip for joining the inner surface of the envelope to the cylindrical wall (column 4, Line 68 to Column 5, line 2); and
  - c. a plurality of bosses (Figure 9, Item 11b and 13')

As a problem with the prior art, Brauner et al. teach (sic) that the sample must be relatively easy to remove from the bottle but also wherein the securing means is strong enough to maintain the sample package on top of the bottle (column 2, line 2-13 and 30-35). Thus it is obvious to use an adhesive tape or layer ... to provide a strong securing means that is resistant to dislocation but is still simple to remove.

Paragraph 23.

As applied to claims 5, 9 and 13 and claims 3-4, 7-8 and 11-12

Brauner et al. (US 5372827) see above

Lemelson (US 3112824) see above

Turpin (US 3962476)

Akutsu et al. (US 4779738)

The examiner finds Brauner et al. and Lemelson silent as to the envelope wall spirally scored but finds that Turpin teaches

- 1) a first cylindrical compartment to hold a first food item (Figure 2, item 16);
- 2) a second cylindrical compartment that holds a second food item (Figure 2, item 10) and
- 3) a spiral score (Figure 1, item 21) an item well established in the art as a common technique for accessing contents within a container. Asutsu further evidences this.

Paragraph 24.

As to claims 1-2, 6, 10, 14-15 and 17

**Franco (US 5743423)**

The examiner states that Franco discloses:

- 1) a diminished diameter bottle neck (Figure 1);
- 2) a snack package containing a snack food (Figure 4) where in the snack package is adapted for wrapping around and over the bottle neck;
- 3) the envelope (Figure 4, Item 10) terminating in a aperture at one end thereof (Figure 4 item 20), wherein the aperture is adapted for accepting the bottle neck...the examiner states that if any portion of a wall is in contact with the bottle wall, then said wall is in intimate contact with said bottle wall.

Franco further discloses wherein the envelope is frictionally engaged with the bottle cap and thus the envelope inherently presses against the bottle neck....

Depending on the type and size of bottle, it would have been obvious to one having ordinary skill in the art that the envelope would have not extended past the width of the bottle. ... Thus it would have been obvious to the ordinary skilled artisan that sizing the snack package to not extend diametrically farther than the bottle would have allowed the combination package to be shelved without occupying additional shelf space.

- 4) a sheath (Figure 3, item 22) for frictional engagement with the bottle cap; and
- 5) protuberances.

Paragraph 25.

As to claim 16

Franco (US 5743423)

Singer (US 6085919)

The examiner states that Singer teaches:

- 1) cylindrical bottle comprising
  - A) a secondary compartment used for storing a prize

- B) annular bosses used to secure a secondary compartment to a bottle neck

Paragraph 15

As to claims 3-5, 7-9 and 11-13

Franco (US 574343423)

Willis (US 45440730)

Akutsu et al. (US4779738)

The examiner states that Franco is silent on teaching adhesive layer and wherein the outer snack envelope is spirally scored so as to enable peeling but Willis discloses:

- 1) a cylindrical bottle;
- 2) overcap; having
  - a) irregular score line (Figure 3, item 31) by which the overcap is removed from the cylindrical bottle (a tamper resistant feature) and that the spiral score of Akutsu verses irregular score would have been obvious.

Paragraph 27.

As to claims 11-13

Schumacher et al. (US 5465825)

Willis (US 454073)

Asutsu (US 4779738)

The examiner states that Schumacher et al teaches:

- 1) securing the second compartment using snap fitting or screw means (figure 1, Items 3 and 15) and is silent as to adhesive layer or strip but finds it obvious that using a snap fitting engagement between the bottle and the second compartment ... to ensure that the second compartment is securely fitted to the bottle. Given the teaching of Willis (adhesive layer or strip) for the purpose of providing tamper evidence.

Paragraph 28.

As to claims 11-13

Muza et al. (US 5397017)

Willis (US 4544073)

The examiner states that Muza teaches:

- 1) securing the second compartment using snap fitting or screw means (Figure 4, Item 30) and is silent on teaching an adhesive layer or strip but Willis "AS TAKEN AS CITED ABOVE, IN PARAGRAPH 17. (Applicant's attorney finds Willis in paragraph 26.) The examiner applies the teaching of Willis to use an adhesive layer to secure SNACK PACKAGE (emphasis added) of Muza et al. to the cylindrical bottle and apply

the irregular score line to facilitate removal and provide tamper evident feature to the snack package.

Paragraph 29.

As Applied to claims 11-13

Willis (US 4544073)

Akutsu et al. (US 4779738)

The examiner finds Setz (cited above teaches:

1. a seal between the snack envelope and the bottle wall (figure 4, item 15)
  - A. The wall that provides the sealing means, further serves to center the cup on the bottle (Column 9, lines 52-55), Setz silent as to adhesive layer or strip BUT THE EXAINER FINDS that the teaching of Setz suggested to one having ordinary skill in the art to secure the snack envelope by using a sealing wall (figure 4, Item 15) so as to ensure **contents within the envelope** (emphasis added) do not escape (column 9, Line 39-63). Additionally Selz teaches maintaining the snack envelope centered on the bottle. This teaching in combination with Willis is obvious to use adhesive layer for maintaining the seal, assuring freshness and provide evidence of tampering. Use of spiral score of Akutsu et al. is well known in the art as a means for facilitating separation of a package.

Paragraph 30

As applied to claim 16

Muza et al. (US 5397017)

Singer (6085919) (sic)

The examiner states that Muza et al. teaches:

- 1) a continuous annular boss but is silent as to the protuberance being a plurality of bosses but Singer teaches:
  - A) cylindrical bottle comprising:
    1. a secondary bottle used for storing a prize
    2. annular bosses used to secure a secondary compartment to a bottle neck.

The examiner asserts that the prior art performs the same function to removably snap fit a container to a bottle neck.

Paragraph 31

As applied to claim 16

Selz (US 5397017)

Singer (6085919) (sic)

The examiner finds that Selz is silent on the teaching of protuberance but Singer teaches:

1. cylindrical bottle comprising:
  - a) secondary bottle for storing a prize;
  - b) annular bosses (well known in the art) to secure the secondary compartment to a bottle neck.

## ATTACHMENT 2 – analysis of the terms adapted for and enabled for

The examiner, Mr. MAI, has objected to the language used by the original attorney. The examiner formed the opinion that the use of the terms “enabled for” and “adapted for” were indefinite and thus unacceptable for use in defining the invention.

Upon reading the specification written by the original attorney, the terms “enabled for” and “adapted for” are liberally used to describe and define the invention as well as the prior art. The terms are used:

1. Page 3, line 1, “for adapting any number of beverage container styles...” Used in context of looking at what beverage container is being used and working with it to perform the function of this invention – combine beverage with snack and place into a vending machine. The adapting can take what ever form, structure, etc. the practitioner may deem feasible, economic, workable, to perform the teaching of the invention.

2. Page 4, line 15, “to enable” the pouch to be suspended...” The prior art is described with the language ...” that appears to be understandable that something must be done to the pouch to function in Barton, U.S. 4,635,291.

3. Page 4, line 24, “adapted to” receive...”. Again the using language is being used to explain a step of doing something to an element so as to perform the teaching of the invention of Bronson, U.S. 3,027,037.

4. Page 5, line 23, “adapted for” being wrapped around or over...” The snack package must be manipulated as it is not originally manufactured for wrapping onto a bottle. Some assembly step with some manual manipulation is required to perform the teaching of the present invention. The original attorney is simply stating that some action is necessary and describing that action.

5. Page 5, line 24 and 25, “adapted for” accepting the bottle neck...” The language is stating what the envelope must be manipulated to do to create the combination taught by the present invention.

6. Page 5, line 26 and 27, “enabled for” pressing the snack package against the bottle neck.” Again the language describes what manipulation must be performed to make the combination in a manner so as to fit back into the vending machine. The combination should not extend the length of the bottle appreciable so it may fit back into the vending machine. The language is precisely limiting the envelope and the combination to be used in the vending machine. The language is being used in a proper manner to describe and limit the steps necessary to perform the teaching of the invention.

7. Page 6, line 7, “that enable...” language to keep the size of the combination so that it fits back into a vending machine – severely limiting and completely understandable by one skilled in the art of combining two or more elements.

8. Page 6, line 10. “that enables...” the merchandising (in other words RAISE THE PRICE). The language is clear in the objective and teaching and applies limits as the combination is to be used in a vending machine.

9. Page 6, line 13, “is enabled...” for use in a standard vending machine. Imposes limits and is readily understandable to restrict the size of the combination taught by the invention.



10. Page 7, line 23, “adapted by its flexibility...” The language clearly limits the snack package used in the invention and thus is proper use of language in defining the limits of the practice of the teaching of the invention. Certainly no boxed snack or hard candy such as a candy cane would be “FLEXIBLE” to come within the limitations imposed by the language used by the original attorney.

11. Page 7, line 27, “adapted by”.. The language limits the size of the combination for practicing the teaching of the invention.

12. Page 8, line 1, “enabled by”...limits the SIZE and SHAPE of the combination and is thus proper use of language in a patent application.

13. Page 8, line 8, “adapted by....” The language places limits on the combination and is thus proper to use in a patent application.

14. Page 9, line 3, “adapted for”. The language limits the combination.

15. Page 9, line 8, “enablement”. Here the original attorney is using the language as an ELEMENT of the invention. The element is a protruberence (sic) item 58, to engage the snack package envelope (50) with the bottle.

16. Page 9, line 17, “to enable”. Here the language is used to describe the ability to open the snack package.

With all the use of the language in the specification it is clearly obvious that the original attorney would continue the use of the language in the claims so that the claims would be supported by the specification, a common practice in writing patent applications. Thus the use of the language is entirely proper in defining the invention as well as placing limitations on the structure and function of the elements taught by the invention.

Applicant’s present attorney response dated 11 January 2001 addressed Examiner MAI’s opinion by expanding the language to structure supported by the specification so as to not introduce new matter.

The new examiner has formed the opinion that the language of the application is functional and not structural. Applicant’s attorney respectfully traverses examiner’s opinion that for example specifying a “snack” package envelope as “having an inner wall and an outer wall having a sealable opening mounted on said outer wall” is functional rather than structural.

Applicant’s attorney respectfully requests examiner to re-evaluate functional vs. structural dichotomy in the review and application of prior art to this application.

Applicant’s attorney respectfully requests the examiner to withdraw the objection to the use of the terms, “adapted for” and “enabled for” as they are substantially supported by the specification.